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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,188	01/24/2002	Rajindra Aneja	4020.000582	5007
23720	7590	02/18/2005	EXAMINER	
WILLIAMS, MORGAN & AMERSON, P.C. 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,188

Applicant(s)

ANEJA, RAJINDRA

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29,31 and 34-54 is/are rejected.
- 7) ☒ Claim(s) 30,32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/24/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 1/24/02 wherein the specification was amended; claims 1-20 were canceled; and claims 21-54 were added.

Note: Claims 21-54 are pending.

APPLICANT'S INVENTION

2. Applicant's invention is directed to phosphoinositide compounds as set forth in independent claims 21, 22, 24, 25, 26, 27, 53, and 54.

112 FIRST PARAGRAPH REJECTIONS (New Matter)

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22, 23, 25, 27-29, 31, 34, 35, 38, 39, 42-52, and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, the structure appearing in the amendment filed 1/24/02 is inconsistent with that of the disclosure (see page 5, line 1). For example, in independent claim 22, line 6, there is two CH₂ groups attached to the phosphorous

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instead of one CH₂ group as set forth in the disclosure. Likewise, independent claims 25, 27, and 54 contain an additional CH₂ group attached to the phosphorous.

It should be noted that all claims depending upon the independent claims contain new matter as well. Hence, claims 23, 28, 29, 31, 34, 35, 38, 39, and 42-52 contain new matter.

112 SECOND PARAGRAPH REJECTIONS

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21, 24, 26, and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims as written are ambiguous because it is unclear what compounds are encompassed by Applicant's phrase 'derivative thereof'. In particular, it is unclear what portion of the parent compound remains in the derivative. Thus, Applicant's is respectfully requested to clarify the claims in order that one may readily ascertain what is being claimed.

DOUBLE PATENTING REJECTIONS

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 22, 23, 25, 27-29, 31, 34, 35, 36-52, and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-13, 20-22, and 29 of U.S. Patent No. 6,376,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to phosphoinositide compounds having a stable isotope. In particular, patented claim 1 differs from the instant invention in that the variable T is only oxygen or 35S while in the instant invention T is defined as oxygen, sulfur, or 35S. Thus, a skilled practitioner in the art would have been motivated to select T as oxygen or 35S since both choices are possible in the instant invention. In

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regards to patented claim 29, when both R2 and R6 are hydrogen, the patented compounds encompass those of independent claims 22, 25, 27, and 54. Hence, it should be noted that both the patented and instant invention are directed to phosphoinositide compounds wherein R2 and R6 are hydrogen atoms; R' and R" may be selected from a fatty acyl, alkyl, or hydrogen; R3, R4, and R5 are independently hydrogen or (Q(T)(O protecting group)₂; T is oxygen or ³⁵S; Q is P, ³²P, or ³³P; and W, X, Y, and Z are independently ²H, ³H, or hydrogen. Furthermore, it should be noted that the structures of the instant and patented invention have at least one stable or radioactive isotope.

Note: The obviousness-type double patenting rejection is based on the structures in the amendment filed 1/24/02 being consistent with those of the specification (see new matter rejection above).

CLAIM OBJECTIONS

9. Claims 30, 32, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

COMMENTS/NOTES

10. It should be noted that no prior art has been cited against Applicant's claims. However, Applicant MUST address and overcome the 112 and double patenting rejections above. In particular, the claims are distinguished over the prior art of record


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because the prior art neither anticipates nor renders obvious compounds as set forth in independent claims 21, 22, 24, 25, 26, 27, 53, and 54.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. Jones
Primary Examiner
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February 15, 2005